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OFFICE OF PETITIONS

In re Application of :
Jakobovits, et al. : DECISION ON APPLICATION
Application No. 10/001,469 : FOR PATENT TERM ADJUSTMENT
Filed: October 31, 2001 :
Atty. Dkt. No.: 511582002420 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)," filed September 8, 2006.

The application for patent term adjustment (PTA) under 37 CFR 1.705(b) is **DISMISSED**.

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b), mailed June 8, 2006, indicated a patent term adjustment (PTA) to date of zero days. The issue fee payment was timely received September 8, 2006. Applicants argue that the correction adjustment is 38 days.

The correct PTA at the time of the allowance is zero days, as indicated on the Determination of Patent Term Adjustment mailed June 8, 2006.

The calculation submitted by applicants contains inaccuracies. Rather than address each inaccuracy in detail, the actual calculation of adjustment is set forth herein.

An adjustment of 30 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(2) in connection with the mailing of the Notice of Allowance. Applicants do not dispute this adjustment. No further delays can be attributed to the Office.

The adjustment is reduced 61 days in accordance with 37 CFR 1.704(b) in connection with applicants' response to the Notice to File Missing Parts mailed December 20, 2001. Applicants do not dispute this reduction.

The adjustment is reduced 62 days in accordance with 37 CFR 1.704(b) in connection with applicants' response to the Office

action mailed September 23, 2003. Applicants do not dispute this reduction.

The adjustment is further reduced 50 days in accordance with 37 CFR 1.704(c)(8) in connection with the information disclosure statement (IDS) filed April 13, 2004. The reduction began February 24, 2004, the day after the date that a reply to the non-final Office action dated February 23, 2004 was filed, and ended April 13, 2004, the date that the supplemental reply (IDS) was filed. Applicants suggest the reduction in this regard should be 260 days. Applicants' calculation fails to acknowledge that the initial reply submitted February 23, 2004 was in response to the Office communication mailed September 23, 2003.

The adjustment is further reduced 89 days in accordance with 37 CFR 1.704(b) in connection with the Notice of Appeal filed June 13, 2005 in response to the final Office action mailed December 16, 2004. Applicants do not dispute this reduction.

Applicants further argue that the patent is entitled to an additional adjustment of 418 days in accordance with 37 CFR 1.704(b) for the Office's failure to issue the patent within three years from the date upon which the application was filed.

Applicants are advised that knowledge of the actual date the patent issues is required to calculate the amount of additional patent term, if any, for Office failure to issue the patent within three years. See, 37 CFR 1.703(b). Thus, applicants' request for reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date of the application is being **held in abeyance** until after the actual patent date.

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B) (and 37 CFR 1.704(b)), the entire period during which the application was pending (except for periods excluded under 35 USC 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 USC 154(b)(1)(B) in determining whether periods of delay overlap under 35 USC 154(b)(2)(A). Thus, any days of delay for Office issuance of the application that overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See, 35 USC 154(b)(1)(B), 35 USC 154(b)(2)(A), and 37 CFR 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Red. Reg. 21704 (April 22, 2004).

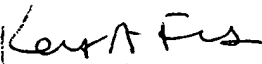
In view thereof, at the time of allowance, the application was entitled to an adjustment of zero days, as indicated in the Determination of Patent Term Adjustment mailed June 8, 2006.

Applicants are further advised that the patent term adjustment indicated in the patent will include any additional patent term accrued pursuant to §§ 1.702(a)(4) and 1.702(b).

The required Patent Term Adjustment application fee of \$200.00 has been charged to applicants' deposit account.

This application is being forwarded to the Office of Patent Publication for further processing.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.


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